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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,616	03/29/2004	Robert R. Parsons	0013	2720

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GO DADDY GROUP, INC.
14455 NORTH HAYDEN ROAD
SUITE 219
SCOTTSDALE, AZ 85260

EXAMINER	
STRODER, CARRIE A	

ART UNIT	PAPER NUMBER
3689	

NOTIFICATION DATE	DELIVERY MODE
10/01/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

inventions@godaddy.com

Office Action Summary	Application No.	Applicant(s)	
	10/811,616	PARSONS, ROBERT R.	
	Examiner	Art Unit	
	CARRIE A. STRODER	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 September 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

3DETAILED ACTION

1. This is in response to the applicant's communication filed on 28 August 2009, wherein:

Claims 1-19 are currently pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 August 2009 has been entered.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. **Claims 1-3, 7-9, 13-15, and 19 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Go Daddy, www.godaddy.com, 02 February 2003 (hereinafter referred to as "Go Daddy", in view of Chauchard et al. (US 20020042719 A1), based on the same reasoning provided in Examiner's previous Office Action.

Referring to claim 1:

Go Daddy teaches:

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I); and

B) the Facilitator’s web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II).

Go Daddy does not teach; however, Chauchard teaches

C) assisting the Entrepreneur in trademarking a name, wherein the Facilitator’s web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name.

Referring to claim 7:

Go Daddy teaches

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I); and

B) the Facilitator’s web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet

protocol address associated with a registered domain name having a label and a top-level domain (Section III; “Hosting”).

Go Daddy does not teach; however, Chauchard teaches

C) assisting the Entrepreneur in trademarking a name, wherein the Facilitator’s web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with receiving hosting services for the website associated with the domain name.

Referring to claim 13:

Go Daddy teaches:

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I); and

B) the Facilitator’s web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II).

C) the Facilitator’s web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet

protocol address associated with a registered domain name having a label and a top-level domain (Section III; “Hosting”).

Go Daddy does not teach; however, Chauchard teaches

D) assisting the Entrepreneur in trademarking a name, wherein the Facilitator’s web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name and with receiving hosting services for the website associated with the domain name.

Referring to claims 2, 8, and 14:

Claims 2, 8, and 14 are dependent on claims 1, 7, and 13; therefore, the rejections of claims 1, 7, and 13 are incorporated herein.

Go Daddy teaches assisting the Facilitator’s web site assisting the Entrepreneur in selecting an available domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business (Section II).

Referring to claim 3, 9, and 15:

Claims 3, 9, and 15 are dependent on claims 1, 7, and 13; therefore, the rejections of claims 1, 7, and 13 are incorporated herein.

Go Daddy teaches the Facilitator’s web site submitting an Entrepreneur's web site associated with the registered domain name to one or more search engines (Section III, as explicated by Section IV).

Referring to claim 19:

Go Daddy teaches:

A) the Facilitator's web site accepting an Entrepreneur over the Internet (Section I); and

B) the Facilitator’s web site receiving information regarding the Entrepreneur that has accessed the Facilitator’s web site (Section I).

C) the Facilitator’s web site storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator’s web site (Section I);

D) the Facilitator’s web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II).

Go Daddy does not teach; however, Chauchard teaches

D) assisting the Entrepreneur in trademarking a name, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name and with receiving hosting services for the website associated with the domain name.

3. **Claims 4-6, 10-12, and 16-18 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Go Daddy in view of Chauchard, as applied to claims 1-3, 7-9, 13-15, and 19, above, and further in view of the United States Patent and Trademark Office, www.uspto.gov, 29 February 2000 (hereinafter referred to as "USPTO") based on the same reasoning provided in Examiner's previous Office Action.

Referring to claims 4, 10, and 16:

Go Daddy and Chauchard fail to teach; however, USPTO teaches linking the Entrepreneur with the official web site for the United States Patent and Trademark Office (Section I).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously with applying for trademarks before the USPTO.

Referring to claims 5, 11, and 17:

Go Daddy and Chauchard do not teach; however, USPTO teaches the steps of receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office (Section III).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously applying for trademarks before the USPTO.

Referring to claims 6, 12, and 18:

Go Daddy and Chauchard do not teach; however, USPTO teaches the steps of receiving trademark information from the

Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the electronic trademark forms to the United States Patent and Trademark Office (Section II).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously with applying for trademarks before the USPTO.

Response to Arguments

Applicant's arguments filed 28 August 2009 have been fully considered but they are not persuasive.

Applicant argues that Chauchard does not teach a Facilitator's web site for facilitating the filing of a trademark. However, Go Daddy teaches a Facilitator's web site, as is provided in the other claim limitations. By combining the prior art references, Examiner is asserting that Go Daddy supplies what Chauchard is lacking - the website. Examiner merely left the claim limitation language whole (i.e. did not previously remove the words "the Facilitator's web site") for ease of review.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Examiner notes the cited portion of Examiner's OA was in the Examiner's response to applicant's arguments and Examiner was merely responding to said arguments, NOT asserting obviousness. To clarify, Examiner asserts that at the time of applicant's invention, it would have been obvious to use a web site, rather than a "mere" software program to provide assistance in filing a trademark, particularly as the USPTO provided an online manner of filing trademarks since at least 29 February 2000 (see the prior art provided with previous Office Action).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed

invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In KSR, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art,"Id. at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."Id. at ___, 82 USPQ2d at 1395. The Supreme Court stated that there are "[t]hree cases decided after Graham [that] illustrate this doctrine." Id. at ___, 82 USPQ2d at 1395. (1) "In United States v. Adams, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." Id. at ___, 82

USPQ2d at 1395. (2) "In Anderson 's-Black Rock, Inc. v. Pavement Salvage Co.,. . . [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation."Id. at ___, 82 USPQ2d at 1395. (3) "[I]n Sakraida v. AG Pro, Inc., the Court derived . . . the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious." SEE MPEP 2141

Exemplary rationales that may support a conclusion of obviousness include:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try " - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. See MPEP § 2143 for a discussion of the rationales listed above along with examples illustrating how the cited rationales may be used to support a finding of obviousness. See also MPEP § 2144 - §2144.09 for additional guidance regarding support for obviousness determinations.

Examiner specifically finds that rationales A) and E) are applicable in this case. Specifically, Examiner asserts that a person of ordinary skill in the art (PHOSITA) at the time of invention would have found it obvious to combine the elements (above) and that in combination, each element merely performs the same function as it does separately. Further, a PHOSITA would have recognized that the results of the combination were predictable. The only difference in the prior art and the instant invention is the combination of the elements into a single website.

Further, Examiner asserts that it would have been "obvious to try" the combination claimed by applicant. The problem or need in the art at the time of invention was that many persons who apply for a domain name also wished to apply for a trademark and to do so, they had to go to separate providers. The only clear solution is for the same provider to provide registration for a domain name and assistance in filing trademarks. One of ordinary skill in the art at the time of invention could have provided this combination.

Applicant asserts that the motivation to combine appears to come from the application. However, he does not recite any specific passages which support his statement. Further, merely because Examiner and applicant both find the same motivation, it does not follow that the motivation is improper. If the motivation is obvious, it is still obvious even when stated by applicant.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARRIE A. STRODER whose telephone number is (571)270-7119. The examiner can normally be reached on Monday - Thursday 8:00 a.m. - 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571)272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CARRIE A. STRODER/
Examiner, Art Unit 3689

/Janice A. Mooneyham/
Supervisory Patent Examiner, Art Unit 3689